



UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office

Address : COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
928,111	7/31/78	John C. Chabala et al	161121A

David L. Rose  
Pat. Dept. Merck & Co., Inc.  
P. O. Box 2000  
Rahway, N.J. 07065

EXAMINER	
B. Hazel	
ART UNIT	PAPER NUMBER
125	5
DATE MAILED: <b>MAILED</b>	

This is a communication from the examiner in charge of your application.

COMMISSIONER OF PATENTS AND TRADEMARKS

APR 20 1979

☐ This application has been examined. ☒ Responsive to communication filed on 2-15-79 ☒ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s),        days from the date of this letter.  
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- ☐ Notice of References Cited, Form PTO-892.
- ☐ Notice of Informal Patent Drawing, PTO-948.
- ☐ Notice of Informal Patent Application, Form PTO-152.
- ☐ \_\_\_\_\_

Part II SUMMARY OF ACTION

- ☒ Claims 1-22 are pending in the application.  
Of the above, claims \_\_\_\_\_ are withdrawn from consideration.
- ☐ Claims \_\_\_\_\_ have been cancelled.
- ☐ Claims \_\_\_\_\_ are allowed.
- ☒ Claims 1-22 are rejected.
- ☐ Claims \_\_\_\_\_ are objected to.
- ☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.
- ☐ The formal drawings filed on \_\_\_\_\_ are acceptable.
- ☐ The drawing correction request filed on \_\_\_\_\_ has been ☐ approved. ☐ disapproved.
- ☐ Acknowledgment is made of the claim for priority under 35 U.S.C. 119. The certified copy has  
☐ been received. ☐ not been received. ☐ been filed in parent application, serial no. \_\_\_\_\_,  
filed on \_\_\_\_\_.
- ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
- ☐ Other

Serial No. 928,111

Art Unit 125

1  
Claims 1-14 and 17-22 are rejected under 35 USC 103 as obvious over the C-076 compounds used as starting materials in the preparation of the compounds instantly claimed. The hydrogenation of the double bond in these compounds is deemed prima facie obvious. There is not seen in the disclosure sufficient teachings to distinguish the instantly claimed compounds patentable over the starting compounds, e.g., unexpected property or increased activity.

Claims 15 and 16 are rejected under 35 USC 103 as obvious over the combined disclosure of the Kishi patent and the Chemical Abstract Citation 86 42838K. The Kishi et al. patent teaches the reduction of double bonds in macrolides of the type instantly claimed by hydrogenating in the presence of a suitable catalyst such as palladium charcoal, platinum oxide, etc. The Chemical Abstract Citation, supra, teaches the use of tris (triphenylphosphore) rhodium Cl as a catalyst in the hydrogenation of double bonds. To combine the teachings of the reference as in the instantly claimed process would appear obvious to a person of ordinary skill in the art having the above disclosures before him and desiring to catalytically reduce unsaturated macrolides.

Applicants' arguments regarding the rejections have been given careful study but are not found persuasive. The remarks in the amendment dated February 15, 1979 concerning the cancellation of claims 15 and 16 have been noted, but there is no direction in the amendment to cancel

Serial No. 928,111

Art Unit 125

said claims. Applicants' remarks concerning the affidavit demonstrating the superior and unexpected properties of the instant compounds over the prior art compound can be given no weight, since said affidavit has not been received.

No claims are allowed.

This rejection is made Final.

B.H.

BHazel:ebw

A/C 703

557-2575

04/12/79

*Johnnie R. Brown*

Johnnie R. Brown  
Primary Examiner  
Art Unit 125